

## **REMARKS**

Claims 1-69 are pending in this application. Claims 1-43 and 67-69 stand rejected under 35 U.S.C. §112. Claims 1-21, 23, 24, 26-30, 35-51, 53-63 and 66-69 stand rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Pub. No. 2003/0050527 to Fox et al. ("Fox"). Claims 22 and 63 stand rejected under 35 U.S.C. 103(a). Applicants respectfully request reconsideration and withdrawal of the rejections based on the following remarks.

### **Rejection under 35 U.S.C. §112**

Claims 1-43 and 67-69 stand rejected under 35 U.S.C. §112 for allegedly failing to particularly point out and distinctly claim the subject matter. In particular, the office action asserts that, in claims 1 and 67, the circuit pad comprises a conductor and a magnetic stimulation device and that Figures 5 and 6 shows the magnetic device separate from the circuit pad. Thus, the office action asserts that the circuit pad does not appear to comprise both a conductor and a magnetic stimulation device.

However, the claims are directed to a circuit pad that reduces discomfort caused by a magnetic stimulation device. While the claims positively recite that the circuit pad comprises at least one conductor, this claimed embodiment does not include a recitation that the circuit pad also includes the magnetic stimulation device. The claims recite the magnetic stimulation device in terms of the functionality of the circuit pad when proximate to a magnetic stimulation device that induces stimulation. In particular, the claims are directed to a circuit pad with a conductor located *proximate* to the magnetic stimulation device.

Further, the claims represent an embodiment described throughout the Specification, where the Specification may describe various embodiments, not just that which is claimed. For example, Applicants refer to para. [0067] of the Application that states,

“Although the arrangement of magnetic stimulation device 501 and conductive coils 503a and 503b are illustrated in Figure 5 in a certain configuration with respect to the patient’s head 502, it should be appreciated that this configuration is not meant to be exclusive, but simply provide one example for the purposes of clarity and explanation.”

Applicants submit that the claims in their present form point out and distinctly claim the subject matter and is consistent with the description throughout the Specification.

### Rejection under 35 U.S.C. §102(e)

Claims 1-21, 23, 24, 26-30, 35-51, 53-63 and 66-69 stand rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Pub. No. 2003/0050527 to Fox et al. (“Fox”).

At the outset, Applicants point out that, in view of the explanation provided for the 35 U.S.C. §112 rejection (Office Action, page 3, lines 1-4), the citation to Fox in the office action appears to be based on the Examiner’s misunderstanding that the claimed circuit pad comprises **both** the conductor and magnetic stimulation device. However, as described above, the claims recite that the circuit pad with the conductor is located **proximate** to the magnetic stimulation device.

The distinction of having a conductor **proximate** to the magnetic stimulation device is significant. The claimed circuit pad includes a conductor and the positioning of the conductor, proximate to the magnetic stimulation device, can reduce the stimulation from the magnetic stimulation device. Thus, in addition to a magnetic stimulation device that is independently capable of inducing stimulation, there is a conductor that can reduce undesirable and painful scalp stimulation caused by the magnetic stimulation device.

The office action refers to Fox’s copper windings wound around a coil, asserting that Fox’s copper windings constitute a conductor and Fox’s coil constitutes a magnetic stimulation device. Thus, the office action concludes that the windings are proximate to a magnetic stimulation device.

However, Fox’s coil, by itself, does not induce stimulation. Thus, the coil, by itself, does not correspond to the claimed magnetic stimulation device. If, as stated in the office action, Fox’s windings are **not** in fact part of a magnetic stimulation device (Office Action, page 9, lines 2-4), then Fox does not teach a stimulation device as Fox’s coil does not induce stimulation without the windings. Further, in the alternative and as previously pointed out by Applicants, if the windings **are** part of Fox’s magnetic stimulation device such that Fox’s magnetic stimulation includes the coil, the windings, and the cabling that connects them (required in order to function

as a stimulator), then it follows that the windings cannot be said to be *proximate to* the magnetic stimulation device if they are *part of* the magnetic stimulation device.

The Examiner refers to paragraph [0153] of Fox which describes a connection from the coil to cabling in order to adapt the coil to a magnetic stimulator. The office action asserts that Fox's coil connected by a cabling to the copper windings represents a connection (i.e., cabling) between a magnetic stimulation device (i.e., coil) and a conductor (i.e., copper windings). However, the coil, with the cabling or without, still does not function as a magnetic stimulation device.

Thus, in accordance with the office action's analysis that Fox's copper windings are proximate to the coil, and that the coil and copper windings are not both part of the magnetic stimulation device, Applicants submit that, based on that analysis, Fox does not teach a magnetic stimulation device because the coil by itself does not function as such. Accordingly, Fox does not teach or suggest a conductor located proximate to a magnetic stimulation device because Fox's coil is unable to provide any magnetic stimulation.

Further, modifying the arrangement of the windings does not accomplish the same thing as the claimed conductor located proximate to the magnetic stimulation device. For example, Fox's paragraph [0150] admits that its technique of the coil with windings wound around the coil has an impact on the coil that generates the field, acknowledging that its technique "comes at the expense of some focusing ability, and coil inductance and heating."

Thus, nowhere does Fox teach or suggest a circuit pad for reducing discomfort having a conductor located proximate to a magnetic stimulation device, wherein the conductor is adapted to reduce stimulation induced by the magnetic stimulation device.

Accordingly, Applicant respectfully requests withdrawal of the rejection of claims 1-21, 23, 24, 26-30, 35-51, 53-63 and 66-69 under 35 U.S.C. §102(e) over Fox.

### **Rejection under 35 U.S.C. §103(a)**

Claims 22 and 63 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Fox in view of U.S. Pub. No. 2001/0018547 to Mechlenburg *et al.* ("Mechlenburg"). Claim 25 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Fox. Claims 31-34, 52 and

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64-65 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Fox in view of U.S. Patent No. 6,477,410 to Henley *et al.* ("Henley").

For the same reasons discussed above with respect to the rejection of claims 1-21, 23, 24, 26-30, 35-51, 53-63 and 66-69 under 35 U.S.C. 102(e) over Fox, applicant respectfully requests withdrawal of the rejection of claims 22 and 63 over Fox and Mechlenburg, claim 25 over Fox, and claims 31-34, 52 and 64-65 over Fox and Henley.

### **Conclusion**

In view of the foregoing, applicant respectfully submits that the claims are allowable and that the present application is in condition for allowance. Reconsideration of the application and an early Notice of Allowance are respectfully requested. In the event that the Examiner cannot allow the present application for any reason, the Examiner is encouraged to contact the undersigned attorney, Lori Anne D. Swanson at (215) 564-8997, to discuss resolution of any remaining issues.

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